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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,086	05/31/2001	John M. Polo	15900.002	3827

7590 11/17/2003
ANNE S. DOLLARD, ESQ.
CHIRON CORPORATION
INTELLECTUAL PROPERTY - R440
P. O. BOX 8097
EMERYVILLE, CA 94662-8097

EXAMINER

CHEN, STACY BROWN

ART UNIT PAPER NUMBER

1648

DATE MAILED: 11/17/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/872,086	Applicant(s) POLO ET AL.	
Examiner Stacy B Chen	Art Unit 1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 August 2003.
- 2a) This action is **FINAL**.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 25-30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 25-30 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 31 May 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) Interview Summary (PTO-413) Paper No(s) _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other:

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DETAILED ACTION

1. Applicant's amendment filed August 25, 2003 is acknowledged and entered. Claims 25-30 are pending and examined.

Claim Rejections - 35 USC § 103

2. The rejection of claims 25-30 under 35 U.S.C. 103(a) as obvious over Dubensky, Jr. *et al* (5,789,245) is maintained for reasons of record. Applicant's arguments have been carefully considered but fail to persuade.

As recorded in Applicant's amendment filed August 25, 2003, in an interview with Dahna Pasternak (Applicant's Representative) and John Polo (Applicant) on May 15, 2003, the issue of plaque assays with regard to alphavirus replicon enumeration was discussed.

Applicant's substantive arguments are primarily directed to the supposed lack of teaching in Dubensky that alphavirus replicon particles are able to be enumerated by plaque assay (5,789,245, column 124, lines 11-21). Applicant argues that Dr. John Polo (an interested party in the present application and a co-inventor in 5,789,245) and co-inventors of the 5,789,245 patent did not even consider enumeration of alphavirus replicon particles by plaque assay at the time of the invention disclosed in 5,789,245.

In response, Dr. Polo's remarks regarding the thoughts and intentions of the inventors of the Dubensky patent are not supported by the facts of record. The Office acknowledges that enumeration of alphavirus replicon particles by plaque assay was not possible because structural proteins were lacking (see 5,789,245, column 124, lines 19-21). However, the present claims are drawn to a method for quantitating alphavirus replicon particles produced in packaging cells

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which provide structural proteins. Dubensky teaches packaging cells containing expression cassettes that provide structural proteins. When Dubensky's vector construct is introduced into the packaging cells (col. 5, lines 64-66), the structural proteins are produced allowing for particles to be produced and detected by plaque assay (col. 19-20, bridging paragraph). Therefore, the presence of structural proteins allows for enumeration by plaque assay.

Conclusion

3. No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Papers relating to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 located in Crystal Mall 1. The Fax number for Art Unit 1648 is (703) 872-9306. All Group 1600 Fax machines will be available to receive

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transmissions 24 hrs/day, 7 days/wk. Please note that the faxing of such papers must conform with the Notice published in the Official Gazette, 1096 OG 30, (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Stacy B. Chen, whose telephone number is (703) 308-2361. The Examiner can normally be reached on Monday through Friday from 7:30 AM-4:00 PM, (EST). If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, James C. Housel, can be reached at (703) 308-4027. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Stacy B. Chen
November 5, 2003


JAMES HOUSEL 11/15/03
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600